

## **REMARKS**

Except as expressly discussed below, any changes made to the application under examination, including the claims, are not made in reply to any rejection or other communication from the Examiner, but are made to improve the clarity, readability, or understanding of the application or a portion of the application that was changed. As is evident, none of the foregoing amendments was made to add new matter, and none was made to narrow the scope of the claims. Indeed, all amendments were made merely as cosmetic amendments to improve the readability and coherence of the resulting patent.

### **Status of Prosecution**

Applicant filed the original application on July 20, 2001. The Examiner mailed a first, non-final office action pertaining to restrictions on August 2, 2002 (Paper No. 4). Applicant filed a Reply to Paper No. 4 on August 26, 2002 (Paper No. 5). The Examiner mailed a first substantive, non-final office action ("Office Action 02" or "Office Action") on December 5, 2002 (Paper No. 6). In reply to Paper 6, Applicant filed a Reply to Paper 6 in which Applicant amended certain claims and added new claims 31-37. Subsequently, on June 6, 2003, the Examiner mailed a second non-final substantive office action, to which Applicant replied. Subsequently, on September 17, 2004, the Examiner filed another non-final office action. This paper is in reply to that office action. As a result, claims 1-37 are pending. Claims 24-30, however, are withdrawn from consideration.

### **Examiner's General Objections and Rejections**

Claims 1, 3-10, 12-32, and 34-49 are pending in the application.

The Examiner allowed claims 38 and 44-49.

The Examiner rejected claims 1, 3-10, 17-19, 21, 31, 32, 34, 37, 39 and 41-43, and objected to claims 5, 12-16, 20, 22, 23, 35, 36 and 40.

### **In the Drawings**

At pages 2-3 of the Office Action the Examiner suggested a drawing figure amendment.

In reply, Applicant determined that the term "perpendicular" was inadvertently used instead of "parallel" both in the specification and in claim 7. Applicant therefore amended claim 7. to delete the word "perpendicular" and substitute instead the word "parallel," and amended the specification by making a parallel amendment in the paragraph also shown in this paper. For

parallel reasoning, Applicant voluntarily amended claim 35. Support for the amendments is found in Figure 8.

### **Specific Objections and Rejections**

On page 4 of the Office Action the Examiner objected to claim 40 as not limiting the previous claim. In reply, Applicant canceled claim 40.

On page 4 of the Office Action the Examiner objected to claims 3 and 4 for the informality of not referencing the proper antecedent claim. In reply, Applicant amended claim 3 to depend from claim 1.

On page 4 of the Office Action the Examiner rejected claims 1 and 3-9 under 35 U.S.C. §112, first paragraph, stating that the specification teaches how the rail rather than the two tracks of the rail are removably mounted on the footing grid. In Reply, Applicant amended independent claim 1.

On page 5 of the Office Action the Examiner rejected claims 39-43 and 3-9 under 35 U.S.C. §112, second paragraph, asserting indefiniteness of claim terminology. In reply, Applicant canceled claim 39.

On pages 5-6 of the Office Action the Examiner rejected claims 1, 3, 4,6-10, 17-19, and 21 under 35 U.S.C. §102(b), stating that U.S. Patent No. 5,957,568 to Byers ("Byers Patent") anticipates those claims, an argument that Applicant respectfully traverses.

On pages 6-7 of the Office Action the Examiner rejected claims 31, 32, 34, and 37 under 35 U.S.C. §102(e), stating that U.S. Patent No. 6,349,912 to Schauss, et al. ("Schauss Patent") anticipates those claims, an argument that Applicant respectfully traverses.

On page 7 of the Office Action the Examiner stated that claims 12-16, 20, 22, 23, 35 and 36, although objected to if rewritten in independent form. Applicant appreciates the Examiner's indication of allowance, but believes Applicant is entitled to a broader scope of coverage.

On page 7 of the Office Action the Examiner stated that claims 39 and 41-43 would be allowable in rewritten to overcome the rejections noted above, and to include all of the limitations of base claim 38 and any intervening claims. In reply, Applicant canceled claims 39-40. Accordingly, applicant submits that independent claim 38, and dependent claims 41-43 are allowable. The Examiner also indicated allowance of claims 44-49.

Applicant respectfully urges, therefore, that the objections and rejections be withdrawn.

**Rejection Under 35 U.S.C. §102(b)**

On pages 5-6 of the Office Action the Examiner rejected claims 1, 3, 4,6-10, 17-19, and 21 under 35 U.S.C. §102(b), stating that the Byers Patent anticipates those claims, an argument Applicant respectfully traverses.

Applicant submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale in this country, more than one year prior to the date of filing of the present application in the United States.

The abstract of the Byers Patent describes “improvements in components for mounting decorative light strings to various mounting sites.” See Abstract, Byers Patent, face sheet. While the Byers Patent includes a number of words used by Applicant to describe elements of the apparatus in the Byers Patent, including, for example, “track” and “channels,” the structure and cooperation of structure of the Byers Patent has no relationship to the examined Application. MPEP §2111.01 does not state that pending claims must be given their broadest reasonable interpretation. Rather, that section clearly requires that “...pending claims must be given their broadest reasonable interpretation consistent with the specification.” Accordingly, while the terms used to describe various elements are similar, the terms describe structural components that cooperate in completely different ways. Terms must be viewed “in light of the specification.”

The Byers Patent also does not satisfy the “all-elements” rule of MPEP §2131, which provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference...The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

Contrary to the Examiner’s argument that all elements are disclosed in the Byers Patent, a footing grid is not, so the rejection of at least independent claims 1 and 10 is unsupported, and therefore should be withdrawn. The Examiner acknowledges the absence of a footing grid, at least implicitly: the Examiner’s enumeration of various elements of the Byers Patent omits a

reference numeral to any structural element that might be a footing grid. See Office Action, line 3 from the bottom of page 5.

Also contrary to the Examiner's argument that all elements are disclosed in the Byers Patent, one or more clamps are not, so the rejection of at least independent claims 1 and 10 is unsupported, and therefore should be withdrawn. The Examiner suggests that clamps are included in the Byers Patent. See Office Action, page 5, last line ("...one or more clamps (64, 74, 102)..."). In fact, however, reference numeral 64 is directed to a "slide channel," see Byers Patent, col. 4, ll. 29; reference numeral 74 is directed to a "slide guide," see Byers Patent, col. 4, ll. 44; and reference numeral 102 is directed to a "gutter clip" wholly unrelated to the clamps of the Application, see Byers Patent, col. 5, ll. 9-10.

Likewise, the Examiner's statements at page 6 of the Office Action that other elements of the Application are found in the reference are incorrect. Accordingly, the rejections of claims 1, 3, 4, 6-10, 17-19, and 21 are unsupported, and therefore should be withdrawn.

#### **Rejection Under 35 U.S.C. §102(e)**

On pages 6-7 of the Office Action the Examiner rejected claims 31, 32, 34, and 37 under 35 U.S.C. §102(e), stating that U.S. Patent No. 6,349,912 to Schauss, et al. ("Schauss Patent") anticipates those claims, an argument that Applicant respectfully traverses.

Applicant again submits, however, that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale in this country, more than one year prior to the date of filing of the present application in the United States.

The Schauss Patent also fails the all-elements requirement of MPEP §2131 as stated above.

The apparatus of the Schauss Patent is, according to that reference, directed to a "supporting structure, especially for attachment to a robot arm and for securing tools...[in which] "the support structure is formed of not less than two shaped bars...[and] the clamping member...is formed of at least two parts..." See Schauss Patent, Abstract, face sheet, emphasis added. Thus, contrary to the Examiner's suggestion that all elements of the Application are disclosed in the Byers Patent, a "slot formed at substantially a right angle to the slot in any other of the at least two tracks" is not. Further, the single "rail" of the application under examination

is not formed of "not less than two shaped bars." Likewise, the clamp of the Application is not formed "of at least two parts." Accordingly, the rejection of independent claim 31, as well as the rejections of dependent claims 32, 34, and 37, are unsupported, and therefore should be withdrawn.

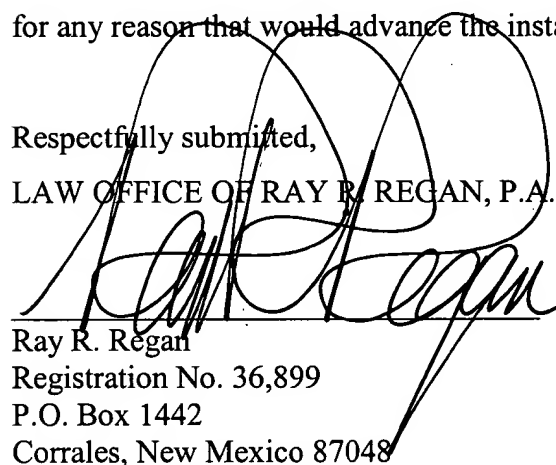
### **Conclusions**

For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 3-10, 17-19, 21, 31, 32, 34, 37, 39 and 41-43, and the objections to claims 5, 12-16, 20, 22, 23, 35, 36 and 40.

The remaining references cited by the Examiner, but not relied on for the rejection of any claims, have been noted. Because the remaining references are no more pertinent than the applied references, a detailed discussion of these remaining references is deemed unnecessary for a full and complete Reply to the Office Action.

In conclusion, Applicant respectfully asserts that this Reply is complete as contemplated in 37 CFR §1.111, that claims are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant respectfully requests an early notice of allowance. The Examiner is requested to call the undersigned at (505) 897-7200 for any reason that would advance the instant application to issue.

Respectfully submitted,  
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